

1771  
RJ

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/021,456 Confirmation No.: 2158  
Applicant : Herbert Hartgrove et al.  
Filed : December 13, 2001  
TC/A.U. : 1771  
Examiner : Jenna Leigh Befumo  
  
Title : Flame-Retardant Imaged Nonwoven Fabric  
  
Docket No. : PGI6044P0281US  
Customer No. : 32116

Commissioner For Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

RESPONSE

Sir:

Responsive to the Official Action mailed July 2, 2004, applicants respectfully traverse the Examiner's rejection under 35 U.S.C. §112, and submit herewith evidence in support of their contention that their application fully complies with the requirements of §112, in that their invention as claimed and disclosed is fully enabling to those skilled in the art. Accordingly, the rejection is respectfully traversed.

By applicants' previously submitted documentation, it is believed that they have demonstrated the commercial availability of the compounds they identify in their application for practice of the present invention, thus supporting applicants' contention that those skilled in the art are familiar with such compounds and their composition.

In further support of their position, applicants submit herewith reference to published literature, reported in *Acta Polymerica*, entitled *Fire Retardant Polyurethanes*, with the abstract of this article characterized as "a literature review on the preparation of

Application No. 10/021,456  
Amendment dated January 3, 2005  
Reply to Office Action of July 2, 2004

fire-retardant polyurethanes based on halogenated compounds is presented." The article is indicated as being received on March 2, 1989, further supporting applicants' position that those skilled in the art are familiar with use of these types of compounds for flame-retardant applications.

Also enclosed herewith is a document executed by named inventor, Herbert Hartgrove, attesting to communications he had with the supplier of the compounds identified in his present application, confirming the use of polyurethane chemistry in the compounds, and his knowledge and belief that the compounds identified in applicants' application are based on a polyurethane background. If the Examiner deems it appropriate, applicant Hartgrove is prepared to execute a sworn Declaration or Affidavit attesting to these communications.

In view of the foregoing, reconsideration of the rejection under 35 U.S.C. §112 is respectfully requested. Applicants plainly disclose the use of a halogenated urethane derivative for imparting flame-retardant properties to applicants' flame-retardant nonwoven fabric, and specifically identify a commercially available formulation, characterized as a "halogenated polyurethane," as being suitable for providing such characteristics. Applicants respectfully refer to M.P.E.P. Section 2164.01, setting forth the test of enablement, which specifically provides that the enablement requirement is met when a person skilled in the art "can make and use the invention without undue experimentation" (citations omitted). The M.P.E.P. goes on to state:

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent *coupled with information known in the art* without undue experimentation (emphasis supplied).

The M.P.E.P. goes on to state:

A patent need not teach, and preferably omits, what is well-known in the art.

As provided in M.P.E.P. Section 2164.01(b), "as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claims, the enablement requirement of 35 U.S.C. §112 is satisfied" (citation omitted). As further provided by the M.P.E.P., "a key issue that can arise when determining whether the specification is enabling is whether the starting materials or apparatus necessary to make the invention are available." Reference is then made to biotechnology, as an example where "starting materials" may not be available.

In the present case, it is respectfully maintained that applicants' specification is *fully enabling*. Specific "starting materials" have been identified, as well as a clear and precise explanation of how such materials should be formulated and employed for manufacture of the present flame-retardant nonwoven fabric.

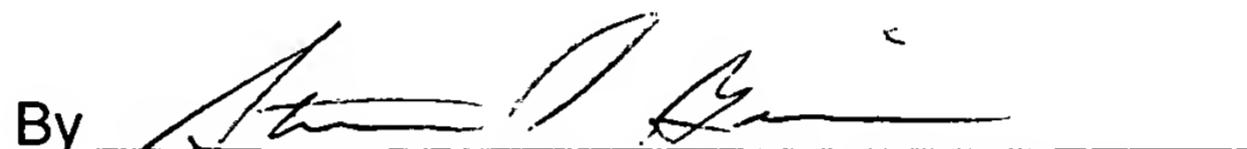
It is respectfully noted that the presently pending claims have not been rejected on the basis of any prior art, thus showing compliance with the requirements of 35 U.S.C. §102 and §103. It is, therefore, respectfully submitted that the rejection under 35 U.S.C. §112 can be withdrawn, and the claims formally allowed, and such action is

Application No. 10/021,456  
Amendment dated January 3, 2005  
Reply to Office Action of July 2, 2004

respectfully solicited. Should the Examiner wish to speak with applicants' attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fee which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

By   
Stephen D. Geimer, Reg. No. 28,846

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
Citicorp Center, Suite 3800  
500 West Madison Street  
Chicago, Illinois 60661-2511  
312/876-1800

**CERTIFICATE OF MAILING**

I hereby certify that this Amendment is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on **January 2, 2005**.

